

REMARKS

Applicant submits this Amendment in reply to the final Office Action mailed December 14, 2004 and Advisory Action mailed April 11, 2005.

By this Amendment, Applicant cancels claim 36, without prejudice or disclaimer, amends claims 35, 46, 54, and 57 to further define the claimed invention, amends the dependencies of claims 37, 41, and 42, and adds new claims 60-62. The originally filed specification, drawings, and claims fully support the subject matter of amended claims 35, 37, 41, 42, 46, 54, and 57 and new claims 60-62. No new matter has been introduced.

Before entry of this Amendment, claims 35-59 were pending. After entry of this Amendment, claims 35 and 37-62 are pending. Claims 35, 54, and 57 are the sole independent claims.

On page 2 of the final Office Action, claim 46 was rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. While Applicant does not necessarily agree with the rejection, in the interests of expediting the prosecution of this application, Applicant has amended claim 46 to remove the objected to terminology. Accordingly, Applicant respectfully requests withdrawal of the Section 112, first paragraph rejection.

On pages 2-5 of the final Office Action, claims 35 and 52 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,786,261 to Tucker ("Tucker"); claims 36-45, 51, and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tucker in view of U.S. Patent No. 5,298,968 to Cheung et al. ("Cheung"), U.S. Patent No. 5,262,841 to Blessner ("Blessner"), and U.S. Patent No. 4,348,111 to Goulas

et al. ("Goulas"); claims 47-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tucker in view of U.S. Patent No. 4,549,809 to Minekane et al. ("Minekane"); and claims 54-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tucker in view of U.S. Patent No. 3,804,535 to Rodriguez ("Rodriguez") and U.S. Patent No. 3,787,124 to Lowy et al. ("Lowy"). Applicant has amended independent claim 35 to substantially include the subject matter of dependent claim 36. Accordingly, because Tucker does not disclose the subject matter now incorporated into claim 35, the Section 102(b) rejection is moot.

As-amended independent claim 35 recites, among other aspects, "moving the accommodation vessel through the light beam via a rotor system" and "allowing the scattered component of the light beam to pass around a diaphragm upon which the transmitted component of the light beam impinges." Independent claims 54 and 57 recite similar aspects. No combination of the cited references discloses or suggests at least these aspects of the claimed invention either alone or in combination with the other aspects of the claimed invention.

Page 4 of the final Office Action admits that "Tucker shows measuring a fluid in a flow cell." The final Office Action then cites Minekane as showing a cuvette system, asserting that "[i]t would have been obvious to use the system of Tucker to measure fluids in cuvettes because it is known that such measurements are useful and replacing the sample holding arrangement of Tucker with a cuvette would not require any modification of the optical system of Tucker." Applicant respectfully disagrees. Tucker discloses a "smaller, simpler, and more efficient system" for sensing forward or back scattered light by eliminating the need for "placing light reflectors in the area around the

light beam and outwardly thereof in positions to receive the forward scattering light and deflect the same toward the photoreceiving surface of a photosensor such as a photomultiplier located downstream of the light beam and in the optical path of the light beam.” (Col. 1, lines 29-38; and col. 6, lines 10-16 and 21-35). Accordingly, Tucker teaches against more complex systems, which would necessarily be the result of replacing the flow cell of Tucker with the cuvette system of Minekane.

The manner in which Tucker accomplishes such a compact system is by placing the photodetecting or photoreceiving surface very close to the sensing zone so as to “reduc[e] the area of photosensitive surface required and increas[e] the solid angle of deflected light sensed by the photosensor.” (Col. 6, lines 24-28). Specifically, Figs. 3 and 4 of Tucker disclose photosensors 32, 66 mounted on block 12 including fluid passageway 14, and Fig. 5 of Tucker discloses photosensor 68 mounted within block 12 with “a photoreceiving surface thereof in line with the inner wall of the fluid passageway 14 and adjacent the view volume.” (Col. 5, lines 54-59). It would be impossible to combine the photosensors 32, 66, 68 of Tucker with the cuvette system in Minekane, as such a mounting would result in one of two scenarios, both of which would not result in a “smaller, simpler, and more efficient system” and also would impermissibly destroy the invention of at least one of Tucker and Minekane. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For example, if photosensor 32, 66, 68 was mounted on a cuvette 12 of Minekane, photosensor 32, 66, 68, and possibly the rest of device 10 of Tucker, would have to travel with the cuvette 12 of Minekane, however, that would impermissibly destroy the invention of Minekane which is to make a photometric measurement of

liquid samples contained in a series of cells. In such a construction, measurements could be made on only one cuvette.

In another example, if photosensor 32, 66, 68 was not mounted to cuvette 12 of Minekane, and the cuvette system of Minekane was allowed to operate normally, the invention of Tucker would impermissibly be destroyed, as such a construction would go against the purposes of the invention in Tucker, which again, is to make a "smaller, simpler, and more efficient system." Specifically, Tucker takes advantage of the benefits of locating the photodetecting or photoreceiving surface 58 close to the sensing zone. Most notably, such a construction reduces the area of photosensitive surface required and increases the solid angle of deflected light sensed by photodetector 32, 66, 68. (Col. 6, lines 24-28). If photosensor 32, 66, 68 was not mounted to cuvette 12, photosensor 32, 66, 68 would, by definition, not be located as close to the sensing zone as if it were mounted on cuvette 12, a feature which is also recited at least in issued independent claims 1 and 3 of Tucker. Thus, the surface area and angle advantages of Tucker would be lost.

Accordingly, because a combination of Minekane and Tucker would require a major modification of one or both references, contrary to the assertion on page 4 of the final Office Action, and as such a combination would impermissibly destroy the purposes of possibly both references, the combination is not proper.

Furthermore, Applicant reiterates the arguments made on pages 11-12 of the Amendment After Final filed March 14, 2005 that Tucker teaches against using a diaphragm. Page 3 of the Advisory Action mailed April 11, 2005 asserts that "[w]hile it is true that Tucker does not use a diaphragm as claimed in claim 36, the fact that

Tucker uses an alternative manner of separating the scattered and directly transmitted light does not remove the use of diaphragms for this purpose, as shown by other cited and applied references, from the art, nor would those in the art, reading Tucker, forget that diaphragms can, and have been, used for this purpose in the art, nor would they mistakenly come to believe that, despite the evidence in the art that such separation arrangements can work, and have worked, that they would not work.” Such is not Applicant’s argument. Applicant’s argument is that while one of ordinary skill in the art may be aware of the use of diaphragms, one practicing Tucker would not use such a diaphragm because Tucker teaches against using diaphragms. If Tucker teaches against the use of diaphragms, there is no motivation to modify Tucker to use diaphragms as suggested, whether or not one of ordinary skill in the art is aware of them or not. Accordingly, because there is not motivation to combine, a proper case of *prima facie* obviousness has not been established.

Additionally, there may be several advantages to using a separate diaphragm and detector(s) as set forth in the claimed invention. For example, such an arrangement may make it easier to substitute diaphragms having various diameters and/or apertures sizes, and furthermore the distance of the diaphragm relative to the detector(s) may be suitably adjusted as necessary. In the integrated diaphragm and detector(s) system of Tucker, such advantages cannot be realized.

Moreover, Applicant further asserts that the final Office Action has not set forth a proper *prima facie* case of how Cheung, Blesener, Goulas, Minekane, Rodriguez, nor Lowy render obvious at least the aforementioned deficiencies of Tucker. Accordingly,

Applicant respectfully requests the allowance of each of independent claims 35, 54, and 57 and their respective dependent claims.

Applicant further submits that claims 37-53, 55-56, and 58-59 depend from one of independent claims 35, 54, and 57, and are therefore each are allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, each of the dependent claims recite unique combinations that are neither taught nor suggested by the cited references and therefore each also are separately patentable.

In view of the foregoing remarks, Applicant submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The final Office Action and Advisory Action contain characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the final Office Action or Advisory Action.


In discussing the specification and claims in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 18, 2005

By: 
Michael W. Kim
Reg. No. 51,880